



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/803,406	03/17/2004	Thomas Weisel	SUS1.PAU.02	5563
23386 7590 12/11/2007 MYERS DAWES ANDRAS & SHERMAN, LLP 19900 MACARTHUR BLVD., SUITE 1150 IRVINE, CA 92612			EXAMINER NGUYEN, TUAN VAN	
			ART UNIT 3731	PAPER NUMBER
			MAIL DATE 12/11/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/803,406

Applicant(s)

WEISEL ET AL.

Examiner

Tuan V. Nguyen

Art Unit

3731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,5-7,9-13,15 and 19-21 is/are pending in the application.
- 4a) Of the above claim(s) 9,11 and 12 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 13,14 and 21 is/are allowed.
- 6) ☒ Claim(s) 1,5-7,19 and 20 is/are rejected.
- 7) ☒ Claim(s) 10 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

Amendment After Non-Final

1. According to the Amendment After Non-Final filed on September 20, 2007, applicants cancelled claims 3-4, 8, 16-18 and 22-27. Now, claims 1, 5-7, 10, 13, 15, and 19-21 are pending in this present application

Response to Amendment

2. Applicant's arguments filed on September 20, 2007 with respect to 102(b) rejection based on Toy reference have been fully considered but they are moot in view of new ground of rejection.

Claim Objections

3. Claims 5 and 6 are objected to because of the following informalities: claims 5 and 6 recite the limitation "The surgical device recited in Claim 4", however, claim 4 was cancelled. Appropriate correction is required.
4. Claim 7 is objected to because of the following informalities: claim 7 recites the limitation "The surgical device recited in Claim 3", however, claim 3 was cancelled.
5. Claim 19 is objected to because of the following informalities: claim 19 recites the limitation "The surgical suturing device recited in Claim ~~4~~ 16", however, claim 16 was cancelled. Appropriate correction is required. Claim 20 is objected to because claim 20 dependent from claim 19.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. **Claims 1 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Toy et al (U.S. Patent 5,618,290) in view of Trott (U.S. Patent 5,312,422).**

9. Referring to **claims 1 and 5-7**, Toy et al disclose a device (1, Figures 2-12) comprising: a hollow elongate shaft (11); a handle assembly (16 and 17) coupled to the shaft (11) wherein the handle assembly (16 and 17) is also a needle lock and having a releasable locking relationship with the needle; a thumb slide (17) moveable on the handle housing in a proximal and distal position relative to the needle assembly creating a free suture state when distal and a captured/locked state when proximal; an actuating rod (3, Figure 4) having a proximal end and

Art Unit: 3731

distal end; a needle assembly (6, 7, 8, 9) disposed at the distal end of rod (3) movable back and forth with the actuating rod between an extended and retracted state; the needle assembly having unitary (clearly shown where 3 points in Figure 4) cylindrical bifurcated portions (backing arm 9 and gathering arm 7) defining a suture slot between; the arms (7, 9) are separate due to spring forces in the extended state and proximate/contacting due to shaft (11) in the retracted state; the needle assembly also comprising a sharp distal tip (6) integral with arm (7) (see col. 3, line 20 to col. 4, line 25). With respect to the limitation "the backing arm and gathering arm of the needle assembly being unitary with one another at a proximal end of the suture slot", Toy discloses the needle shaft 3 or actuating rod, the pointed head 6 or sharp distal tip, the hook 8, and the latch 9 or gathering arm, bifurcated portions, which is located between the shoulder or hook 8, latch 9 or gathering arm and the bottom portion of needle shaft that connected to the sharp needle tip 6 or the backing arm, are fabricated from a single piece of 174-PH grade stainless steel (see col. 4, lines 33-36). With respect to the limitation "the bifurcated portions having a proximate and spaced relation ship when the needle assembly is in the retracted state", Toy discloses the gathering arm is created by two cuts that perpendicular to each other thereby forming a L-shaped groove 7 (see col. 4, lines 40-50), thusly, Toy inherently discloses that some material will be removed by the cutting operation thereby there will be a small gap between the gathering arm and the backing arm when the needle assembly is in the retracted state.

Art Unit: 3731

10. Still referring to **claims 1 and 5-7**, Toy discloses the invention substantially as claimed except for clearly discloses the distal portion of the gathering arm extending proximally from the sharp distal tip to form a hook. However, Trott disclosed such a feature on his suturing needle. Trott discloses a suturing needle (see Figs. 4 and 5) comprising: needle assembly 14 having a recess 44 or bifurcated portion near its distal end 32 wherein the recess 44 is adjacent and abutting hook 46 for capturing the suture (see col. 3, lines 50-68). Therefore, it would have been obvious to one of ordinary skill in the art to incorporate the hook, as disclosed by Trott, to the needle, as disclosed by Toy in order to gain the advantage of providing a positive suture locking mechanism before the needle is fully in retracted state as suggested by Trott.

Allowable Subject Matter

11. Claims 13, 15 and 21 are allowable over prior art of record.
12. Claim 10 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
13. Claims 19-20 would be allowable if they are amended to overcome the objection above.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit: 3731


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tuan V. Nguyen whose telephone number is 571-272-5962. The examiner can normally be reached on M-F: 9:00 AM - 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Todd Manahan can be reached on 571-272-4713. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tuan V. Nguyen
December 6, 2007



Todd E. Manahan
SPE 3731